

\$6p 1645

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Bernadette B. Fahey  
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August 2, 1999  
Date

Att. Dkt. No. - REG 32

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



**Applicants:** Matthew LaVail, et al.

**U.S. Serial No.:** 08/897,390

**Examiner:** R. Hayes

**Filing Date:** July 21, 1997

**Group Art Unit:** 1645

**Title:** PREVENTION OF RETINAL INJURY AND DEGENERATION BY  
SPECIFIC FACTORS

August 2, 1999

Assistant Commissioner of Patents and Trademarks  
United States Patent and Trademark Office  
Washington, DC 20231

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SIR:

**RESPONSE TO JUNE 4, 1999 RESTRICTION REQUIREMENT AND REQUEST FOR ONE  
MONTH EXTENSION OF TIME**

This paper is submitted in connection with the above-identified application as a response to the Restriction Requirement which was mailed by the United States Patent and Trademark Office on June 4, 1999. A response to the June 4, 1999 Restriction Requirement was due on July 4, 1999. A one month extension of time, from July 4, 1999 to and including August 4, 1999 is hereby requested. The fee for a one month extension of time is \$110.00 and a check in that amount is enclosed. A response is due by August 4, 1999 and as such this Response is being timely filed.

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Disposition of Claims

Claims 1-38 are pending in the application and are the subject of a restriction requirement. Group I includes claims 1-35, drawn to methods of reducing or preventing degeneration of retinal neurons in a mammal comprising administering neurotrophic factors. Group II includes claims 36-38, drawn to methods of assessing the survival-promoting ability of an agent on retinal neurons or photoreceptors.

REMARKS

Applicants hereby provisionally elect Group I, consisting of claims 1-35 and respectfully traverse the restriction requirement with respect to Group II.

The Examiner has taken the position that the subject application contains two separate inventions, identified by the Examiner as Groups I and II, and that these inventions are distinct from each other. However, the Examiner points out that there are no provisions under the section for "Relation of Inventions" in M.P.E.P. 805.05 for inventive groups that are directed to different methods.

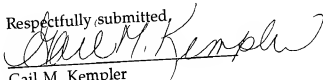
Under 35 U.S.C. § 121, restriction is proper if two or more independent and distinct inventions are claimed in one application. With respect to Groups I and II, Applicants contend that it would not be a serious burden on the Examiner to search Groups I and II together. A search of the literature for the methods of Group I would be very similar, if not identical, to the search performed for the methods of Group II and would necessarily turn up references concerning both groups. Both Groups include methods involving degeneration of neurons or photoreceptor cells and administration of agents, including neurotrophic factors, to the eye. Applicants contend that methods of preventing or reducing neuronal or photoreceptor degeneration include an implicit need to assess the survival-promoting ability of the agents used to prevent or reduce the degeneration.

Conversely, methods of assessing the survival-promoting ability of an agent on retinal neurons or photoreceptors implicitly includes prevention or reduction of degeneration. Therefore, Applicants respectfully contend that restriction of claims 1-38 into two Groups is not proper and request that the Examiner reconsider and withdraw the restriction requirement. Applicants believe that because all of the claims of Group I and Group II are so closely related, they should remain in the same application to preserve unity of invention. M.P.E.P. § 803 states, "If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct and independent inventions." Applicants believe the claimed inventions satisfy this requirement.

Applicants reserve the right to file a divisional application for the claimed subject matter of Group II and do not waive any rights or abandon any subject matter in the non-elected claims of Groups II.

No fee, other than the fee for a one month extension of time, is deemed necessary in connection with filing this response. However, if any fee is necessary, authorization is hereby given to charge the amount of any such additional fee to Deposit Account No. 18-0650.

Respectfully submitted,



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